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612.41024X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Norbert KOHLER et al
Serial No.: 10/030,222
Filed: April 1, 2002
For: System And Method Intended For Thermal
Insulation Of A Pipe With Vegetable Foam
Art Unit: 1745
Examiner: J. Rhee

REPLY BRIEF

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 3, 2007

Sir:

This Reply Brief is being submitted under 37 C.F.R. §41.41 in reply to the Examiner's Answer mailed November 2, 2006, in connection with the above-identified application.

The Examiner continues to argue that "it would have been obvious to one having ordinary skill in the art to provide Beauquin whose invention is directed to thermal and acoustic insulation with the biologically degradable polymer foam taught by Boehmer et al. whose invention is directed to packaging for the purpose of providing a foam that retains its shape and compressibility under non-wetted conditions but disintegrates when subjected to continuous water." The Examiner's reasoning lacks a basis in the prior art or in the knowledge available to one of

ordinary skill in the art. Moreover, the prior art cited by the Examiner actually teaches away from the proposed combination.

As noted in Appellants' Appeal Brief, the Boehmer et al. patent teaches the use of its material for the formation of loose-fill packaging materials, similar to those popularly known as "foam peanuts," and a foam sheet for use in packaging. There is absolutely no suggestion in Boehmer et al. that the material described therein should be used for thermal insulation, especially filling a volume defined by a space contained between a first enclosure interior to a second enclosure. The Examiner has not explained why the property of the Boehmer et al. material she identifies, i.e., the ability to retain its shape and compressibility of non-wetted conditions but to disintegrate to a pulverous or amorphous mass when subjected to a continuous liquid water phase, would have been seen by one of ordinary skill in the art to be a property useful for thermal insulation of pipes.

The Examiner relies on U.S. Patent No. 5,705,536 to Tomka "to merely support Examiner's argument." In the first place, as Appellants have previously pointed out (see the Request for Reconsideration filed May 23, 2006), the reliance of the Tomka patent without positively including the patent in the statement of the rejection is improper. Moreover, the mere mention in Tomka that polymer foams can be used in "packaging, thermal insulation, acoustic insulation, construction and many fields of use of daily life" in no way suggests its use for a thermal and/or acoustic insulation of a tube intended to allow the outflow of hydrocarbons originating in oil deposits, as such as a very specialized insulation application.

In any event, the prior art cited by the Examiner actually teaches away from the Examiner's proposed combination. In particular, the primary reference to

Beauquin discloses that it is known "to use pumping to introduce a liquid loaded with solid particles, or a liquid gel, between the two walls from one of the ends of the tube." However, the Beauquin patent specifically teaches away from using a liquid loaded with solid particles since it discloses that "its thermal insulation performance is mediocre because of the high residual conductivity of the medium" and "long-term stability of these formulations at a temperature of above 85°C. is difficult to obtain (sedimentation of the particles in the case of loaded liquids, loss of viscosity in the case of liquid gels)." See, column 2, lines 6-28 of Beauquin. For the foregoing reasons, it is submitted it would not have been obvious to use the material of Boehmer et al. as a thermal and/or acoustic insulant in the system of Beauquin. Any conclusion to the contrary is merely a hindsight reconstruction of the prior art based on the teachings in Appellants' specification.

For the foregoing reasons, and the reason set forth in the Appeal Brief filed August 23, 2006, the final rejection should be reversed.

To the extent necessary, Appellants petition for an extension of time under 37 C.F.R. §1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (612.41024X00) and please credit any excess fees to such Deposit Account.

Very truly yours,

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